

III. REMARKS

Applicant elects group I, claims 1-5, 7-21 with traverse and respectfully requests reconsideration of the restriction requirement. Applicant elects the species of Group I, claims 12-13, with traverse.

The Applicant respectfully notes that the Restriction in this Action is defective, and the reasons given by the Examiner in support of the restriction are specious at best. The Examiner is reminded that a restriction is proper if (A) the inventions are independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and (B) there would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808 and § 808.02) (see also MPEP § 803).

All of the claims of Groups I-III relate to the same concept, namely a mobile initiated handover system.

Claim 1 recites "initiating **an intersystem handover of a mobile terminal**...by a transmission of said mobile terminal... **wherein a criterion for said intersystem handover is one of a requested content, a requested access point name, a requested uniform resource location and a requested internet protocol address.**"

Claim 22 recites a "**mobile terminal** comprising...a transmitter configured to transmit a...direct request for a specific type of radio access network indicating that **an intersystem handover** from a radio access network of a first type...should be performed... **wherein a criterion for the selection of the specific type radio access network for the direct request is one of a requested content, a requested access point name, a requested uniform resource location and a requested internet protocol address**"

Claim 26 recites "components configured to perform **an intersystem handover of a mobile terminal...upon a transmission received from said mobile terminal...wherein a criterion for the intersystem handover is one of a requested content, a requested access point name, a requested uniform resource location and a requested internet protocol address.**"

Thus, it is respectfully submitted that the invention groups identified by the Examiner are not independent or distinct, but rather relate to the same inventive concept.

Furthermore, it is submitted that the requisite requirements for restriction have not been satisfied. It is first noted that this application is well advanced in the prosecution phase, and all of the claims have previously been examined. The first Office Action on this application was issued in **September 2004**. It is inappropriate that it is only now, nearly 4-1/2 years later, that restriction is required.

The Examiner merely asserts that "there would be a serious search and examination burden if the restriction were not required because one or more of the following reasons apply." However, the Examiner only lists some general conclusory statements or guidelines. The Examiner does not provide any specific reasons as to why there is a serious search and examination burden, particularly in light of the prior examination of the claims. MPEP §803 requires that the Examiner **state the reasons** supporting the conclusion that the claims in the application are drawn to patentably distinct species (see also MPEP 806.05(c)). However, no such reasons are included in the Action. Accordingly, the Restriction is defective and should be withdrawn.

Also, as demonstrated above, claims 1, 22 and 26 have similar features and thus, the assertions by the Examiner related to different fields of search, different non-prior art issues and applicability of the prior art are not at issue here. This is also supported by

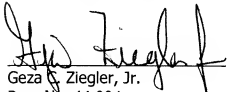
the prior search and examination of these claims. Further, there is no evidence that claims 1, 22 and 26 have acquired separate status. Thus, the restriction requirement appears to be based on nothing more than mere conclusory statement that amounts to no more than a bare restriction.

It is noted, that the above is not and should not be construed as either an admission or confirmation that any inventions and species, are or are not, patentably distinct. Rather, it is a notation that the Restriction as made is defective and should be withdrawn.

It is also submitted that the issuance of this restriction requirement, nearly 4-1/2 years after the first office action is prejudicial to the Applicant. MPEP §707.07(g) states that "piecemeal examination should be avoided." Applicant has made every effort to expedite the prosecution of this application. However, the prosecution has not progressed to any great degree. Each rejection of the claims has been rebutted by the Applicant. Yet, further obstacles continue to be raised, that if valid, should have brought to the attention of the Applicant much sooner in this process. This application has now had more than three Office Actions and was filed well over 5 years ago. MPEP §707.02 states that the "supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them." Thus, not only should this restriction be withdrawn, but also in light of all of the prior searches and examinations, and rebuttals of the grounds of rejection, this case should proceed to allowance. Consideration is respectfully solicited.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any overpayment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza G. Ziegler, Jr.
Reg. No. 44,004

23 Feb 2009
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512